

### **REMARKS**

Applicants appreciate the Examiner's thorough examination of the subject application and request reconsideration of the subject application based on the foregoing amendments and the following remarks.

Claims 1-21 are pending in the subject application. While the Office Action Summary indicates that claims 1-21 are pending; claim 3 was previously canceled in the Response dated November 7, 2005. As such Applicants understand that claims 1, 2 and 4-21 are pending in the subject application.

Claims 14-21 were withdrawn from consideration as the result of an Examiner's earlier restriction requirement. In view of the Examiner's restriction requirement, Applicants reserve the right to present the above-identified withdrawn claims in a divisional application.

Claims 1-13 stand rejected under 35 U.S.C. §102 and/or 35 U.S.C. §103.

As indicated above, Applicants previously canceled claim 3 and thus Applicants understand that any reference to claim 3 being rejected is incorrect. In view of this obvious mistake, Applicants respectfully submit that the Office Action is incomplete because it does not appear that claim 1 was considered in its as-amended form. Also, the Office Action provides that claims 1-5 stand rejected because of a new grounds for rejection, but the grounds for rejection appears to be the same as that provided in the previously mailed Office Action. Consequently, Applicants respectfully submit that the next Office Action on the merits should not be made final. Notwithstanding this, and in the interests of advancing prosecution Applicants have

responded to the Office Action as follows.

Claim 1 was amended to include the limitations of claims 4 and 5. Also, claims 4 and 5 were canceled in the instant amendment without prejudice to prosecuting them along with pending claim 1 in a continuing application.

Claim 2 was canceled in the instant amendment without prejudice to prosecuting this claim in a continuing application.

Claim 6 was amended for clarity, namely to make clear that the dividing is done after sticking of the polarizer plate so that the substrate with the polarizer thereon is divided so as to thus, yield the plurality of liquid crystal panels with the polarizer(s) already disposed on the substrate.

Claim 7 was amended for clarity so as to more particularly described the partial removal of the polarizer plate and dividing of the substrate thereafter.

The amendments to the claims are supported by the originally filed disclosure.

#### 35 U.S.C. §102 REJECTIONS

The Examiner rejected claim 6 under 35 U.S.C. §102(b) as being anticipated by Sasaki [US 20010040667]. Applicants respectfully traverse. Because claim 6 was amended in the instant amendment, the following discussion refers to the language of the amended claim. However, only those amended features specifically relied upon to distinguish the claimed invention from the cited prior art shall be considered as being made to overcome the cited

reference.

As indicated herein, Applicants amended claim 6 to make clear that the dividing occurs after the polarizer is stuck on the at least one of the first substrate and second substrate. In other words, when the substrates is being divided according to the method of the present invention the substrate with the polarizer thereon is being divided to yield the plurality of liquid crystal panels, where each panel would have a polarizer stuck thereon.

The method steps in claim 6 were arranged so that the step of dividing followed the step of sticking the polarizer plate to at least one of the first and second substrates; however, it appears from the remarks in the Office Action, in particular those remarks provided in regards to the rejection of claims 7 and 8-10, that the sticking and dividing steps of claim 6 are not being read as being in the sequence provided in claim 6. For example, in the rejection of claims 8-10 it is asserted that Sasaki in view of Takeshi teaches attaching polarizers prior to the division step. As such, and as admitted by the Examiner Sasaki alone does not disclose or teach attaching a polarizer plate to the substrate prior to the step of dividing.

Applicants amended claim 6 so as to clarify that the step of dividing followed the step of sticking and further indicates that the substrate with the polarizer thereon is what is being divided into the plurality of liquid crystal panels. It this is respectfully submitted that Sasaki does not anywhere disclose or described dividing affixing the polarizer plate to the substrate prior to dividing the substrate into the plurality of liquid crystal panels.

As provided in MPEP-2131, a claim is anticipated only if each and every element as set

forth in the claim is found, either expressly or inherently described, in a single prior art reference.

*Verdegal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Or stated another way, “The identical invention must be shown in as complete detail as is contained in the ... claims. *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d. 1913, 1920 (Fed. Cir. 1989). Although identify of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990). It is clear from the foregoing remarks that the above-identified claim is not anticipated by the cited reference.

It is respectfully submitted that for the foregoing reasons, claim 6 is patentable over the cited reference and satisfy the requirements of 35 U.S.C. §102(b). As such, claim 6, including the claims dependent therefrom are allowable.

### 35 U.S.C. §103 REJECTIONS

Claims 1-5 and 7-13 stand rejected under 35 U.S.C. §103 as being unpatentable over the cited prior art for the reasons provided on pages 3-8 of the above-referenced Office Action.

As indicated herein, claim 3 was previously canceled by Applicants. Thus, claim 3 is not addressed further herein.

As also indicated herein, claim 1 was amended to include the limitations of claims 4-5. Also claim 2 is canceled in the foregoing amendment. As such, Applicants do not believe that the within rejection as to these canceled claims need be specifically addressed further herein.

As to claims 1 and 7-14, because claims were amended in the foregoing amendment, the

following discussion refers to the language of the amended claim(s). However, only those amended features specifically relied on in the following discussion shall be considered as being made to overcome the prior art reference. The following addresses the specific rejections provided in the above-referenced Office Action.

### **CLAIM 1**

Claim 1 stands rejected under 35 U.S.C. §103<sup>1</sup> as being unpatentable over Poensgen et al. [USP 4,061418; “Poensgen”] in view of Takeshi et al. [JP 54-0939951; “Takeshi”] for the reasons provided on pages 3-5 of the above referenced Office Action. Applicants respectfully traverse.

In regards to this rejection Applicants would note, that in the specific grounds for the rejection, the secondary reference is identified as “Takeshi Japanese Publication No. 54-0939951” and in the Office Action mailed August 9, 2005 it was further indicated that this reference was “as supplied by applicant.” The Japanese Publication submitted by Applicants is not the publication number identified in the Office Action, but rather is Japanese Publication No. 54-030051. As such, Applicants have addressed the rejection with regards to what was asserted in connection with the Takeshi Japanese Publication that had been submitted by Applicants.

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<sup>1</sup> The Office Action provides that the rejection is under 35 U.S.C. §102(b), however, the rejection is located in the rejections under §103 and the language used in the rejection is that used in a rejection under §103. Thus, Applicants have treated the rejection as being one under §103.

The Office Action asserts that the primary reference discloses the invention as claimed except that it fails “to disclose limitation of the polarizing plate having a surface with an inclination at the end.” It is further asserted that Takeshi discloses use of a triangular shaped blade to cut a polarizing plate “with that results in an end surface that is inclined that improves cutting quality, workability and yield.” Applicants respectfully disagree with the assertions as to that which is allegedly disclosed in Takeshi. In support of Applicants arguments, Applicants submit herewith a translation of the text of the Japanese Publication.

Nowhere in Takeshi is it described, suggested or taught that the blade shape depicted in the figure was there so as to cause the end surface to be inclined. In fact, the entirety of the discussion in Takeshi is directed to the problems associated with the adhesive material layer on a polarizing plate sticking to the machinery cutting the polarizer plate. In sum, the end surface resulting from the cutting process described in Takeshi would appear to be normal or essentially normal and not inclined.

In sum, there is nothing in Takeshi that would suggest to one skilled in the art to cut a polarizing plate that is being affixed to a substrate so that an end surface of the polarizing plate would be inclined.

It is respectfully submitted that claim 1 is patentable over the cited reference(s) for the foregoing reasons.

## **CLAIM 7**

Claim 7 stands rejected under 35 U.S.C. §103 as being unpatentable over Sasaki [US 20010040667] in view of Takeshi [JP 54-03051] for the reasons provided on pages 5-6 of the above referenced Office Action.

In regards to this rejection, Applicants would note that the specific grounds for the rejection identifies Terada as the primary reference and not Sasaki. As such, Applicants have addressed the rejection with regards to what was asserted in connection with claim 6 as to the disclosures of Sasaki and the added assertions as to what is allegedly disclosed in Takeshi. Also in regards to the secondary reference, Applicants would note that a typo appears in the citation of the reference in the grounds for rejection [*i.e.*, the reference identified by Applicants is 54-030051 whereas it is 54-030041 in the office action; underlining added to identify the typo). It should be noted that it appears that the Examiner was referring to Applicants' identified reference based on the remarks in the Office Action.

It is asserted in the Office Action that the primary reference (Sasaki) discloses all limitations of the claimed invention except attaching a polarizing plate prior to dividing and partially removing portions to allow the substrate to have a surface exposed and dividing the first and second substrates. It is further asserted that the secondary reference (Takeshi) discloses cutting an exterior portion that is performed prior to division. It thus is asserted that Sasaki once combined with Takeshi would yield the method of claim 7. Applicants respectfully traverse.

Claim 7 depends from claim 6. As indicated in the discussion above regarding claim 6, Sasaki does not disclose the invention of claim 6. It is respectfully submitted the combination of Sasaki and Takeshi also does not include any teaching or offer any suggestion for the method of claim 6, as well as not providing any teaching, suggestion, or offer any motivation for modifying the method described in Sasaki so as to yield the method of claim 6. It thus is respectfully submitted that claim 7 is considered to be allowable at least because this claim depends from a base claim that is considered to be allowable. This shall not be construed as an admission that claim 7 is not otherwise separately patentable from the identified combination of references.

Notwithstanding the foregoing, Applicants offer the following comments regarding the rejection of claim 7. It first should be noted that the abstract in Takeshi does not describe or teach a method for removing a portion of the polarizer plate after it has been stuck to at least one of the first or second substrates. As stated in the Patent Abstracts of Japan, the invention described in the cited reference is a cutting method of a polarizing plate for a liquid crystal display element. The purpose section of the Abstract also provides that the described technique is a cutting method for a polarizing plate. As such, the description in the Abstract while describing a method for cutting the polarizing plate, does not provide a basis by which one skilled in the art would have been informed that the polarizing plate was to be stuck to one or both of the substrates, a portion of the polarizing plate is to be removed to expose a surface of the underlying structure and thereafter one would divide the substrate in the exposed surface region



of the substrate. This lack of disclosure and teaching also is evidenced with reference to the translation of Takeshi being provided herewith.

In sum, there is nothing in Takeshi that would suggest to one skilled in the art to divide a substrate having a polarizing plate thereon so as to form a plurality of LCD panels, each thus having a polarizing plate affixed thereto.

It is respectfully submitted that claim 7 is patentable over the cited reference(s) for the foregoing reasons.

#### **CLAIMS 8-10**

Claims 8-10 stand rejected under 35 U.S.C. §103 as being unpatentable over Sasaki [US 20010040667] in view of Takeshi [JP 54-03051] and in view of Nagata et al. [JP 11-338376; “Nagata”] for the reasons provided on pages 6-7 of the above referenced Office Action.

As grounds for the rejection, the above-referenced Office Action provides that Sasaki in view of Takeshi discloses all of the limitations of claims 8-10 “except inspection of more than one liquid crystal cell via an interconnection electrically connected to each liquid crystal for inspection before the step of stick or after the step of sticking.” Applicants respectfully traverse.

Each of claims 8-10 depend from claim 6. As indicated in the discussion above regarding claim 6, Sasaki does not disclose the method of claim 6. It is respectfully submitted the combination of Sasaki, Takeshi and Nagata also does not include any teaching or offer any suggestion for the method of claim 6, as well as not providing any teaching, suggestion, or offer

any motivation for modifying the methods described therein so as to yield the method of claim 6.

It thus is respectfully submitted that each of claims 8-10 are considered to be allowable at least because each depends from a base claim that is considered to be allowable. This shall not be construed as an admission that claims 8-10 are not otherwise separately patentable from the identified combination of references.

In addition and as discussed above in connection with claim 7, the combination of Sasaki and Takeshi does not disclose a method in which the polarizer plate is stuck to the substrate prior to said step of dividing and that said step of dividing divides the substrate with the polarizer plate thereon. As such, it is further submitted that contrary to the assertion in the Office Action, there is no teaching or suggestion provided in either reference or by the combination that would teach or suggest modifying a conventional method so as to yield the method claimed by Applicants. Thus, it is respectfully submitted that for this further reason, each of claims 8-10 are considered to be patentable from the identified combination of references.

It is respectfully submitted that claims 8-10 are patentable over the cited reference(s) for the foregoing reasons.

#### **CLAIMS 11-13**

Claims 11-13 stand rejected under 35 U.S.C. §103 as follows. Claims 11 and 12 stand rejected under 35 U.S.C. §103 as being unpatentable over Sasaki [US 20010040667] in view of Shimamune et al. [USP 5,684556; "Shimamune"] for the reasons provided on page 7 of the

above referenced Office Action. Claim 13 stands rejected under 35 U.S.C. §103 as being unpatentable over Sasaki [US 20010040667] in view of Shimamune et al. [USP 5,684,556; “Shimamune”] and further in view of Stefanov et al. [USP 5,953,289; “Stefanov”] for the reasons provided on pages 7-8 of the above referenced Office Action. Applicants respectfully traverse.

Each of claims 11-13 depend directly or ultimately from claim 6. As indicated in the discussion above regarding claim 6, Sasaki does not disclose the method of claim 6. It is respectfully submitted that the combination of Sasaki and Shimamune or the combination of Sasaki, Shimamune and Stefanov also does not include any teaching or offer any suggestion for the method of claim 6, as well as not providing any teaching, suggestion, or offer any motivation for modifying the methods described therein so as to yield the method of claim 6. It thus is respectfully submitted that each of claims 11-13 are considered to be allowable at least because each depends from a base claim that is considered to be allowable. This shall not be construed as an admission that claims 11-13 are not otherwise separately patentable from the identified combination of references.

In addition and as discussed above in connection with claim 7, Sasaki does not disclose a method in which the polarizer plate is stuck to the substrate prior to said step of dividing and that said step of dividing divides the substrate with the polarizer plate thereon. As such, it is further submitted that contrary to the assertion in the Office Action, there is no teaching or suggestion provided in either reference or by the combination that would teach or suggest modifying a

conventional method so as to yield the method claimed by Applicants. Thus, it is respectfully submitted that for this further reason, each of claims 11-13 are considered to be patentable from the identified combination of references.

It is respectfully submitted that claims 11-13 are patentable over the cited reference(s) for the foregoing reasons.

The following additional remarks shall apply to each of the above.

As provided in MPEP 2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F. 2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F. 2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As provided above, the references cited, alone or in combination, include no such teaching, suggestion or motivation.

Furthermore, and as provided in MPEP 2143.02, a prior art reference can be combined or modified to reject claims as obvious as long as there is a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Additionally, it also has been held that if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. Further, and as provided in MPEP-2143, the teaching or suggestion to make the claimed combination and the reasonable suggestion of

success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As can be seen from the forgoing discussion regarding the disclosures of the cited references, there is no reasonable expectation of success provided in the reference(s).

As provided in MPEP-2145 (XD) a prior art reference that "teaches away" from the claimed invention is significant factor to be considered in determining obviousness. It also is provided therein that the totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of non-obviousness. *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). As indicated herein, the methodologies described in both primary references as well as the display produced by such methods is directed to conventional arts and not to the methodology claimed by Applicants.

As the Federal circuit has stated, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. *Para-Ordance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.2d 1085, 1087, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995). In as much as both primary references are directed to conventional methods, it necessarily follows that a modification of the described methodology would be necessarily based on the teachings of the subject application.

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It is respectfully submitted that for the foregoing reasons, claims 7-13 are patentable over the cited reference(s) and thus satisfy the requirements of 35 U.S.C. §103. As such, these claims are allowable.

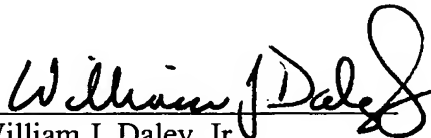
It is respectfully submitted that the subject application is in a condition for allowance. Early and favorable action is requested.

Applicants believe that additional fees are not required for consideration of the within Response. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. **04-1105**.

Respectfully submitted,  
Edwards & Angell, LLP

Date: May 24, 2006

By: \_\_\_\_\_

  
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